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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,287	07/27/2001	Kurt M. De Grosz	20884-000210	8096

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,287

Applicant(s)

DE GROSZ ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12162002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed on 07/21/01. Claims 1-32 are pending.

Claim Rejections - 35 USC § 112

2. Claim 1 recites the limitation " the employee benefits industry" in line 1. There is insufficient antecedent basis for this limitation in the claim. Applicant is required to give a thorough explanation as to what type of "the employee benefits industry" is referring to. Appropriate correction is needed in the next correspondence.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-32 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-32 only recite an abstract idea. The recited steps of an enrollment and benefits administration module coupled to said client management module for providing an employer with a set of employer tools for benefits administration for an employee and for and for processing a benefit product for said employee does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of a system database coupled to said at least one server for storing said employer record and said employee record.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces an enrollment and benefits administration module coupled to said client management module for providing an employer with a set of employer tools for benefits administration for an employee and for and for processing a benefit product for said employee (i.e., repeatable) used in storing said employer record and said employee record (i.e., useful, and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-32 are deemed to be directed to non-statutory subject matter.

In order for a claim to be statutory, the claimed invention must produce a useful, concrete, and tangible result and having "a computer system" or "a computer-medium" tied with the body of the claim in performing the recited steps.

As such, claims 1-32 do not recite any application or use of the technological arts, and thus equally rejected under 35 U.S.C.101.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10, 12-15 and 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Technology Breathes New Life Into Proposals by Haskins, Steven. Life & Health Insurance Sales. Indianapolis: Oct.1992, Vol.135; Iss. 10; pg.8, 2 pgs) in view of Sherman et al (2002/0124188).

(A) As per claim 1, Haskins discloses a system for the employee benefits industry, said system comprising:

a client management module for providing a broker with one or more broker tools for generating an employer record and employee record (See Haskins, Page 1, Paragraphs 1-3);

a presale module coupled to said client management module for providing said

broker with one or more workflow tools, said workflow tools enabling a request for proposal (RFP), a renewal functionality, electronic submission of said RFP to an insurance carrier and receiving a response to said RFP (See Haskins, Page 1; Paragraphs 1-3);

an enrollment and benefits administration module coupled to said client management module for providing an employer with a set of employer tools for benefits administration for an employee and for and for processing a benefit product for said employee (See Haskins, Page 2, Paragraphs 5-13).

Haskins does not explicitly disclose that the system having a system database coupled to said at least one server for storing said employer record and said employee record.

However, this feature is known in the art, as evidenced by Sherman. In particular, Sherman suggests a system database coupled to said at least one server for storing said employer record and said employee record (See Sherman, Page 2, Paragraphs 0020-0021).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Sherman within the system of Haskins with the motivation of providing a database and a server and uses Internet technology to extend the benefits of the corporate network to corporate clients and their advisors, without compromising the security and efficiency of the existing corporate network (See Sherman, Page 1, Paragraph 0008).

(B) As per claim 2, Haskins discloses the system for the employee benefits industry comprising an eligibility and billing module coupled to said client management module to allow for the consolidation and production of a single bill for premiums and transmission of eligibility to carriers (See Haskins, Page 1, Paragraphs 1-3 through Page 2, Paragraph 4).

(C) As per claim 3, Sherman discloses the system for the employee benefits industry further comprising a worksite marketing module coupled to said customer module to enable distribution of an ancillary product (See Sherman, Page 2, Paragraphs 0021-0025).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Sherman discloses the system for the employee benefits industry wherein said renewal functionality allows said broker to organize upcoming plan renewals and to submit an electronic renewal request to an insurance carrier and receive a response to said electronic renewal request (See Sherman, Page 5, Paragraphs 0051-0054).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Sherman discloses the system for the employee benefits industry wherein said workflow tools comprise benefit plan designs offered by a plurality of insurance carriers (See Sherman, Page 4, Paragraphs 0042-0043).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Haskins discloses the system for the employee benefits industry wherein said workflow tools comprise a merging tool that merges said response to said RFP into an employer presentation (See Haskins, Page 1, Paragraphs 1-3).

(G) As per claim 7, Haskins discloses the system for the employee benefits industry wherein said set of broker tools allows collection, management and data mining of said employer record and RFP and renewal information (See Haskins, Page 1, Paragraphs 1-3).

(H) As per claim 8, Sherman discloses the system for the employee benefits industry wherein said set of employer tools allows correlation of said employee with a payroll record, said employee record and a 401(k) record (The Examiner interprets IRA account to be a form of payroll record, said employee record and a 401(k) record See Sherman, Page 6, Paragraphs 0060-0061).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(I) As per claim 9, Sherman discloses the system for the employee benefits industry wherein said set of employer tools further comprises a report writer that organizes and generates census information and carrier billing (See Sherman, Page 6, Paragraphs 0066-0067).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, Sherman discloses the system for the employee benefits industry wherein said enrollment module comprises a set of self-service tools (See Sherman, Page 5, Paragraph 0055).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(K) As per claim 12, Sherman discloses the system for the employee benefits industry further comprising a worksite-marketing module (See Sherman, Page 8, Paragraphs 0090-0091).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(L) As per claim 13, Haskins discloses the system for the employee benefits industry wherein said worksite marketing module offers said employee said benefit product

selected from the group consisting of life insurance, disability insurance, long term care insurance, homeowners insurance, auto insurance, personal umbrella liability insurance, an annuity and a mutual fund (See Haskins, Page 1).

(M) As per claim 14, Haskins discloses the system for the employee benefits industry wherein said worksite marketing module includes a streaming video ad for said benefit product (See Haskins, Page 2, Paragraphs 10-13).

(N) As per claim 15, Sherman discloses the system for employee benefits industry wherein said worksite marketing module includes a link to a carrier (See Sherman, Page 2, Paragraphs 0020-0021).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(O) As per claim 17, Sherman discloses the system for the employee benefits industry wherein a change in said demographic profile will prompt said worksite marketing module (See Sherman, Page 8, Paragraphs 0090-0091).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(P) As per claim 18, Sherman discloses the system for the employee benefits industry wherein said billing module reconciles payments from a plurality of insurance carriers (See Sherman, Page 4, Paragraphs 0042-0043).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(Q) As per claim 19, Sherman discloses the system for the employee benefits industry wherein said billing module allows an employee to pay individual premiums for certain worksite products (See Sherman, Page 6, Paragraphs 0063-0065).

(R) As per claim 20, Sherman discloses the system for the employee benefits industry of wherein said benefit product is selected from the group consisting of medical insurance, dental insurance, vision insurance, life insurance, std insurance, LTD insurance, death benefits, term life insurance, workers compensation, a section 125 plan, whole life insurance, variable life insurance, annuities, mutual funds, IRA, travel accident and accidental death and dismemberment, employee assistance programs, individual homeowner's insurance, renter's insurance, auto insurance, umbrella liability insurance, health insurance, non-qualified retirement plans, and 401(k) plan (See Sherman, Page 6, Paragraph 0060).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(S) As per claim 21, Sherman discloses the system for the employee benefits industry of claim 1, wherein said networked environment is selected from the group consisting of a worldwide computer network, the Internet, a wide area network, a local area network, and an intranet (See Sherman, Page 5, Paragraph 0049).

The motivation for combining the respective teachings of Haskins and Sherman are as discussed above in the rejection of claim 1, and incorporated herein.

(T) As per claim 22, Haskins discloses a method for procuring a benefit product in a networked environment, said method comprising:

providing a broker with a set of workflow tools enabling a request for quote (RFP) of said benefit product to an insurance carrier and receiving a response from said insurance carrier of said RFP;

providing an employer with a set of employer tools for administration of said benefit product for an employee; and

enrolling said employee in said benefit product offered by said insurance carrier, thereby procuring said benefit product in a networked environment (See Col.).

(U) As per claim 26, Sherman discloses the method for procuring a benefit product further comprising real-time quoting (See Sherman, Page 6, Paragraph 0065).

7. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Technology Breathes New Life Into Proposals by Haskins, Steven. Life & Health

Insurance Sales. Indianapolis: Oct.1992, Vol.135; Iss. 10; pg.8, 2 pgs) in view of Sherman et al (2002/0124188) as applied to claims 1-10, 12-15 and 17-32 above and further in view of Mangin et al (6,078,890).

(A) As per claim 11, Haskins and Sherman disclose the system for the employee benefits industry wherein said set of self-service tools (See Sherman, Page 5, Paragraph 0055).

Haskins and Sherman do not explicitly disclose that the system having a plan comparison sheet, a provider directory, and a personal demographic profile.

However, this feature is known in the art, as evidenced by Mangin. In particular, Mangin suggests that the system having a plan comparison sheet, a provider directory (See Mangin, Col.3, lines 1-31) and a personal demographic profile (See Mangin, Col.4, lines 17-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Mangin within the collective teachings of Haskins and Sherman with the motivation of improving method and system for collecting and processing health care provider information to increase efficiency and accuracy of managed care rate renewal in an abbreviated or timely manner (See Mangin, Col.1, lines 54-57).

(B) As per claim 16, Mangin discloses the system for the employee benefits industry of claim 1, wherein said employee record includes a demographic profile (See Mangin, Col.4, lines 17-45).

(C) Claims 23-24, 27-30 and 31-32 recite the underlying process steps of the elements of claims 5-6, 8-11 and 20-21, respectively. As the various elements of claims 5-6, 8-11 and 20-21 and have been shown to be either disclosed by or obvious in view of the collective teachings of Haskins, Sherman and Mangin, it is apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in method claims 23-24, 27-30 and 31-32 are rejected for the same reasons given above for claims 5-6, 8-11 and 20-21, and incorporated herein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches 401 Konnect Launches Internet 401 (k) Marketplace, Online Sales Resource for Brokers and Vendors by PR Newswire. New York: Apr 17, 2000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30 am-5:00pm.

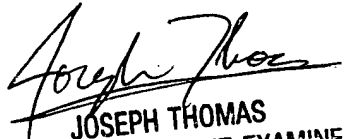
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

September 23, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3500